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EXAMINER

KANTAMNENI, SHOBHA

| ART UNIT | PAPER NUMBER |
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1617

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/485,903 | Applicant(s) DUPUIS ET AL. | |
| | Examiner Shobha Kantamneni | Art Unit 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-26, 28-36, 40-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) NONE is/are allowed.
- 6) ☒ Claim(s) 18-26, 28-36, 40-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the response filed on 09/13/2006.

No claim amendments are made in the response filed on 09/13/2006.

Applicant's arguments have been fully considered, but not found persuasive, and the rejection of claims 18-26, 28-36, and 40-48 under 35 U.S.C. 103(a) as being unpatentable over Feder et al. (US 5,721,026, of record) in view of both Dubief et al. (US 6,024,946, of record), and Bolich (EP 0 240 349, of record) is MAINTAINED. See under response to arguments.

Claims 18-26, 28-36, and 40-48 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-26, 28-36, and 40-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feder et al. (US 5,721,026, of record) in view of both Dubief et al. (US 6,024,946, of record), and Bolich (EP 0 240 349, of record).

Feder et al. discloses a composition comprising aqueous silicone dispersion comprising (a) an oil-in-water emulsion of an α,ω -dihydroxypoly-diorganosiloxane (a non-aminated α,ω -disilanol), (b) an aqueous dispersion of an insoluble organic

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(co)polymer particles having a particle size ranging from 0.01 to 0.5 μm , in an amount of 20 to 70 % by weight comprising monomer units selected from alkyl(meth)acrylates (such as butyl acrylate, methyl methacrylate, etc.), unsaturated esters of monocarboxylic acids, vinylaromatic compounds (such as styrene, 4- methylstyrene, etc.), unsaturated carboxylic acids (such as acrylic acid, etc.) and others. See abstract; column 23-24, claims 19, 28; column 5, line 19-column 6, line 38. It is also taught that aqueous dispersion contain particle size ranging from 0.15 μm to 100 μm originating from emulsion of α,ω -dihydroxypoly-diorganosiloxane. See column 7, lines 15-17. Feder et al. teaches that the dispersions disclosed therein can be useful as cosmetic compositions for the treatment of hair, especially for achieving permanent waving. See col. 11 , lines 6-13.

Feder et al. does not teach propellants, and a percent of weight of non-aminated α,ω -disilanol as ranging from 0.05 to 10 % by weight.

Feder et al. does not specifically teach a hair setting lotion, and a process of rinsing the hair.

Dubief et al. teaches a composition for the treatment of keratinous materials consisting essentially of an aqueous medium, at least one silicone, at least one latex consisting colloid suspension of polymer particles insoluble in said aqueous medium, and at least one suspension agent for the silicone and the latex and/or at least one thickening agent (Abstract). Specifically disclosed is a non-rinsed conditioner comprising an o/w emulsion of acrylamide/sodium 2-methyl propanesulfonate acrylamide copolymer, a latex of vinyl acetate/acrylic ester copolymer, and a mixture of

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octamethylcyclotetrasiloxane dimethiconol and dodecamethylcyclopentasiloxane (col. 8, Example 1). The silicones comprise 0.1-50% of the composition and the latex polymer particles comprise 3.1-10% of the composition (col. 7, lines 26-36). Propellants are disclosed as additives (col. 7, lines 48-53). The compositions may be used as a rinsed or non-rinsed treatment lotion for application before or after shampooing, before or after perming, before or after dyeing or bleaching or between two perming or straightening steps (col. 7, lines 57-61).

Dubief et al. does not teach the amount of propellant as ranging from 15 to 35 % by weight.

Dubief also does not teach the particular propellants such as n-butane, propane, isobutene, pentane etc as in claim 34.

Bolich teaches an aerosol hair cosmetic aqueous composition comprising a silicone elastomer, a propellant and, optionally, a hair setting polymer dispersible in an aqueous phase. See Abstract; page 2, lines 40-50; page 3, lines 18-39. It is taught that the propellant generally makes up 3-30% w/w of the composition (preferably about 5-15% w/w), and that it may be propane, n-butane, dimethylether, etc. See page 3, lines 3-16.

It would have been obvious to one of ordinary skill in the art at the time of invention to employ the percent weight of silicone as from about 0.05 to 10 % into the invention of Feder et al. because (1) Dubief et al. teaches ranges of silicone and polymer particle weight percentages that either encompass or overlap with the percentages of the claims of the instant invention, and (2) it has been held that where

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the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

One of ordinary skill in the art would have been motivated to prepare a composition of Feder et al. with the weight percentages of Dubief et al. because of an expectation of success in preparing a hair cosmetic composition capable of the treatment of hair because (1) Feder et al. and Dubief et al. are both drawn to compositions comprising similar components (such as an aqueous component, a silicone component, a polymer particle component, etc); (2) both Feder et al. and Dubief et al. teach that the compositions therein are useful for treating hair.

It would have been obvious to a person of ordinary skill in the art at the time of invention to employ a propellant in the composition of Feder because Dubief teaches analogous formulations, useful for treating hair containing additives such as propellants.

It would have been obvious to one of ordinary skill in the art to utilize the specific weight percentages of the specific propellants as claimed in the instant invention because it is taught by Bolich that aqueous hair cosmetics comprising a silicone elastomer and a hair setting polymer may be aerosolized and contain a propellant, preferably 5-15 %. Accordingly, Bolich teaches an analogous art comprising the instant specific propellants within the amount ranges as claimed in the instant application. One would have been motivated to add a propellant in the weight percentage of the instant application to the composition of Feder et. al. because, as taught by Bolich, such preparations are useful as hair styling mousses. See page 2, lines 1-3.

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It is noted that the claims of the instant application are directed to a composition comprising an aqueous dispersion comprising at least one insoluble polymer particle, an emulsion comprising 0.05-10% non-aminated silicone -disilanol, 15-35% propellant, and a cosmetically acceptable medium, wherein the composition is in the form of an aerosol. Any properties exhibited by or benefits provided by the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure or composition, the properties Applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not possess the same properties of the instant claimed product. The prior art teaches applicant to keratinous substances, such as hair, of compositions containing the same components as instantly claimed, which would necessarily possess the property of being a hair-setting lotion, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art composition does not exhibit the same properties as those instantly claimed.

Response to Applicant's Arguments:

Applicant argues that "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art....the Office clearly ignores all three sources and instead, looks to Applicant's invention. " These arguments have been considered, but not persuasive. Feder et al. discloses a composition comprising

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an α,ω -dihydroxypoly-diorganosiloxane (a non-aminated α,ω -disilanol), an insoluble organic (co)polymer particles having a particle size ranging from 0.01 to 0.5 μm , comprising monomer units selected from alkyl(meth)acrylates (such as butyl acrylate, methyl methacrylate, etc.), unsaturated esters of monocarboxylic acids, vinylaromatic compounds (such as styrene, 4- methylstyrene, etc.), unsaturated carboxylic acids (such as acrylic acid, etc.) and others. It is also taught that aqueous dispersion contain particle size ranging from 0.15 μm to 100 μm originating from emulsion of α,ω -dihydroxypoly-diorganosiloxane. Feder et al. does not teach the amount of α,ω -dihydroxypoly-diorganosiloxane, and does not teach propellants in the cosmetic compositions taught therein. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time of invention to look to an art to determine the amount of silicone, and propellants known in the art to be useful in the treatment of hair. Dubief et al. teach compositions for treatment of keratinous materials comprising polyalkylsiloxanes (see column 10-12, claims 1, 5, 7) similar to dihydroxypoly-diorganosiloxane employed by Feder et al. in the amounts as instantly claimed, and the compositions of Dubief can comprise propellants depending on the intended use. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time of invention to employ α,ω -dihydroxypoly-diorganosiloxane in the amount of 0.05 to 10 % by weight in the composition of Feder et al. because Dubief et al. teaches analogous hair care composition comprising similar siloxanes in such amounts. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of invention to employ propellants in the hair care compositions taught by Feder et

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al. because Dubief teaches analogous hair care compositions, and teaches that the compositions therein can contain propellants depending on the intended use. Accordingly, it would have been obvious to a person one of ordinary skill in the art to determine the acceptable form of delivery of cosmetic compositions suitable for hair care treatment.

Applicant argues that "Dubief, however, does not disclose any siloxane in the form of an emulsion. Infact, Dubief states that silicones "may be in the form of oils, waxes, gums or resins." This arguments has been considered, but not found persuasive. It is respectfully pointed out that Dubief need not teach siloxane in the form of emulsion. Dubief reference was employed to determine the total amount of siloxane that can be employed in hair treatment compositions.

Applicant argues that "Feder teaches that "the emulsion (A) prepared by emulsion polymerization or by emulsifying the silicone polymer is in the form of an oil-in-water emulsion and preferably has a solids content of at least 40 % by weight." Feder at Col.5, ll. 13-16. This suggests that the solids content is a central factor for Feder's silicone emulsions. But despite this teaching, the Office imports for combination a teaching directed to anything but an emulsion" This argument has been considered, but not found persuasive because the applicant's claims are drawn to a composition comprising non-aminated silicone α,ω -disilanol, wherein the amount of non-aminated silicone α,ω -disilanol is 0.05 to 10 % by weight with respect to the total weight of the cosmetic composition, and not to the weight of the non-aminated silicone α,ω -disilanol in the emulsion. Thus, one of ordinary skill in the art at the time of invention would be

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motivated to look for an art to determine the amount of silicone in the hair care composition which can be used for hair treatment, and combine with Feber et al. Thus, as discussed above there is clear motivation to combine Feder et al. with Dubief.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period, will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday, 7.30am-4.00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, Ph.D can be reached on 571-272-0629. The fax

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phone number for the organization where this application or proceeding is assigned is
571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni, Ph.D
Patent Examiner
Art Unit : 1617



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER